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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/309,128	05/10/99	FRANKENBACH G	7258XR

IM62/0128

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EXAMINER	
HARDEE, J	
ART UNIT	**PAPER NUMBER**
1751	4

DATE MAILED: 01/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/309,128	Frankenbach et al.
Examiner	**Group Art Unit**
John R. Hardee	1751

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-30* is/are pending in the application.

Of the above, claim(s) *6, 8-14, and 19-25* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-5, 7, 15-18, and 26-30* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. Claims 1-30 are generic to a plurality of disclosed patentably distinct species comprising fabric softeners, phase stabilizers and principal solvents. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of fabric softener, stabilizer and principal solvent, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Jason Camp on January 24, 2000 a provisional election was made with traverse to prosecute the invention of di- and triesterquat fabric softeners, the genus of phase stabilizers recited at section D1 of claim 1, and 2,2,4-trimethyl-1,3-pentanediol as the principal solvent, claims 1-5, 7, 15-18 and 26-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6, 8-14 and 19-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species. Examiner notes that Mr. Camp stated that the ClogP value of the elected solvent is 0.34.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5, 7, 15-18 and 26-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the principal solvents recited in the specification, does not reasonably provide enablement for any and all conceivable solvents meeting the ClogP recitation. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or practice the invention commensurate in scope with these claims. Examiner recommends that the claims be limited to the disclosed solvents most of interest to applicant.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5, 7, 15-18 and 26-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has recited "at least an effective level of principal solvent". Effective to do what? How much is an effective amount? Examiner recommends that this recitation be replaced or supplanted with percentage limitations to overcome this rejection. The amount of solvent recited in claim 28 is also indefinite. If the amount of solvent is critical to maintaining a stable composition, applicant should recite percentages and supply data to support the claim to criticality.

With regard to claims 29 and 30, it is unclear what applicant means by "block copolymers of ethylene oxide and propylene oxide". This recitation appears clear until it is read in light of the specification. This section of the specification discloses polymers which do not contain ethylene oxide and propylene oxide in blocks, polymers which need not contain both ethylene oxide and propylene oxide, and well as polymers which comprise blocks of ethylene oxide and propylene oxide in addition to other groups. Examiner understands the term "block copolymers of ethylene oxide and propylene oxide" to refer to materials which *consist of* EO and PO blocks. If something else is meant by this term in the context of claims 29 and 30, explanation on the record is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-5, 7, 15-18 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wahl et al., US 5,759,900. Patentees disclose liquid fabric softening compositions which

may be clear, said compositions comprising 2-80% of a diester quat or triester quat fabric softening active, wherein the ester groups are of 12-22 carbons. No specific iodine value is disclosed, but it is particularly preferred that at least about 15% of the ester groups contain polyunsaturation (col. 2, lines 55-59). Canola oil feedstock is disclosed at col. 4, line 44. The alkyl groups are of 1-6 carbons and may be hydroxylated (col. 2, lines 36+). Compositions further comprise less than about 40% of a principal solvent having a ClogP value of about 0.15 to about 0.64. Said principal solvent may comprise 50-80% of TMPD, with the balance being 1,4-cyclohexanedimethanol. Magnesium and calcium compounds are optional but particularly preferred ingredients of the compositions at 0 to about 2% by weight. Chlorides are preferred (col. 27, line 66+). Viscosity limitations are not disclosed, but examiner takes the position that applicant's recited viscosities man be met in the course of following the teachings of the reference. The phase transition limitations of claims 3 and 4 are not disclosed by the reference, but if the elected class of softeners do not or cannot meet this limitation, then these claims do not read on the elected species of fabric softener. This reference does not disclose a composition which exemplifies applicant's claims.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

11. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wahl et al., 5,759,990 as cited above in view of Wahl et al., US 5,545,340. The `990 is summarized above. Addition of a stabilizer as recited in claim 29 is not disclosed. However, the `990 discloses at col. 27, lines 54+ that the surfactant concentration aids disclosed in application 08/461,207 may be added to the compositions. This application has since been allowed as the `340. The `340 discloses that nonionic surfactants may be added to liquid compositions at 0 to about 5%, where the surfactants have an HLB of about 7 to about 20 (col. 9, lines 5+). These include n-decyl alcohol bearing 11 equivalents of ethoxylation (col. 11, line 45). It would have been obvious at the time the invention was made to add such a concentration aid to the composition of the `990, because the `990 teaches that the concentration aids of the `340 may be added to the compositions disclosed in the `990.

Allowable Subject Matter

12. Claim 30 might be allowable, depending on what applicant means by the recitation of "block copolymers of ethylene oxide and propylene oxide"

13. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art is Wahl et al. `990 as summarized above. It is known to add block copolymers of ethylene oxide and propylene oxide to fabric softening compositions which are coated onto substrates, such as dryer sheets. US 5,102,564 is exemplary of this. While one might make a liquid fabric softening composition containing such a copolymer for the purpose of coating and

solidifying it onto a dryer sheet, there would be no motivation to add TMPD to such a composition.

14. The prior art made of record and not relied upon is of interest and is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 7:30 until 4:00. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

John R. Hardee
Patent Examiner
January 24, 2000